

REMARKS

In the Office action dated February 14, 2006, the Examiner rejected claims 1-11 and 24 under 35 U.S.C. § 101; rejected claims 1-26 under 35 U.S.C. § 112, second paragraph; and rejected claims 1-26 under 35 U.S.C. § 102(a) as being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over "Proper Conduct of Banking Business" (*Proper Conduct*). Based on the following remarks, Applicants respectfully traverse the rejections under 35 U.S.C. §§ 102(a) and 103(a).

The Examiner asserts that claims 1-11 and 24 recite non-statutory subject matter because the method in claims 1-11 "is not concrete nor is it tangible" (Office action at p. 2). The Examiner states that "the method must be performed on a computer and the computer must be claimed within the body of the independent claim(s)." The Examiner further states that claim 24 "is nonstatutory as it is not embedded on a computer readable medium."

Applicants respectfully submit that claim 1, as amended, recites a method which is executed on a data processing system. Therefore, the method is performed on a system and this feature is claimed in the body of independent claim 1. Claims 2-11 depend upon claim 1. Because claims 1-11 are directed to the technological arts and recite statutory subject matter, Applicants respectfully request the Examiner withdraw the rejection of claims 1-11 under 35 U.S.C. § 101.

Claim 24 recites, *inter alia*, "a computer-readable medium including instructions for performing a method when executed by a processor, for notifying a guarantor of events likely to affect a guaranteed loan." Because claim 24, as amended, is directed to

the technological arts and recites statutory subject matter, Applicants respectfully request the Examiner withdraw the rejection of claim 24 under 35 U.S.C. § 101.

The Examiner asserts that claims 1-26 are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention” (Office Action at p. 2). According to the Examiner, the recitation “providing loan data with information” is confusing. Applicants respectfully refer the Examiner to MPEP § 2173.02. In relevant part, MPEP § 2173.02 states,

“The essential inquiry pertaining to this requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of: (A) The content of the particular application disclosure; (B) The teachings of the prior art; and (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.”

Applicants respectfully direct the Examiner to page 2, lines 15-17 of the application disclosure that discloses one implementation consistent with the claims. The method and apparatus of claims 1-26 “provides loan data with information on at least one guaranteed loan wherein the loan data includes information about the loan,” such as the terms thereof. Therefore, in light of the disclosure, claims 1-26 are clear and definite. Applicants respectfully request the Examiner withdraw the rejection of claims 1-26 under 35 U.S.C. § 112, second paragraph.

The Examiner asserts that claims 1-26 are anticipated by, or in the alternative, are unpatentable over *Proper Conduct*. The Examiner states that *Proper Conduct* “may have been published after the effective filing date of this application.” In such case, “the examiner takes official notice the similar banking codes of conduct have existed prior to the effective filing date of this application” (Office Action at p. 3). Applicants respectfully

traverse the rejection based on this reference. Firstly, the Examiner has not demonstrated that the reference was in fact published before the priority date for this application. Applicants also traverse the taking of Official Notice and refer the Examiner to MPEP § 2144.03. In relevant part, MPEP § 2144.03 states, "If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding." Applicants submit that the Examiner has made a generalized statement without any documentary evidence to support it.

Applicants traverse the Examiner's taking of "Official Notice," noting the impropriety of this action, as the Federal Circuit has "criticized the USPTO's reliance on 'basic knowledge' or 'common sense' to support an obviousness rejection, where there was no evidentiary support in the record for such a finding." *Id.* Applicants submit that "[d]eficiencies of the cited references cannot be remedied by general conclusions about what is 'basic knowledge' or 'common sense.'" In re Lee, 61 USPQ2d 1430, 1432-1433 (Fed. Cir. 2002), quoting In re Zurko, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Should the Examiner maintain the rejection under 35 U.S.C. §102(a) or 35 U.S.C. § 103(a) after considering the reasoning presented herein, Applicants submit that the Examiner must provide "the explicit basis on which the examiner regards the matter as subject to official notice and allow Applicants to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made," or else withdraw the rejection. See MPEP § 2144.03.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 14, 2006

By: 

Jeffrey A. Berkowitz
Reg. No. 36,743